

Serial No. 09/889,341
Attorney Docket No. 6386-08-IM

REMARKS

I. Status of the Application

This paper responds to a Restriction Requirement (Paper No. 6), which was mailed on August 4, 2003. The Application was filed with 5 claims. This paper cancels claims 1 and 2 without prejudice or disclaimer, amends claims 3 through 5, and adds new claims 6-8. Therefore, claims 3-8 are currently pending. Applicant respectfully requests entry of the amendment and examination on the merits.

By action taken here, Applicant in no way intends to surrender any range of equivalents beyond that needed to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves all such equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

II. Amendment of Claims 3-5

Applicant has amended claims 3-5 to correct typographical errors. In addition, Applicant has amended claims 3-5 so that they now depend on new independent claim 6 instead of canceled claims 1 and 2.

III. New Claims 6-8

Applicant has added new claim 6, which combines original claims 1 and 2 and addresses stylistic differences between German and U.S. patent claims practice. In addition, claim 6 recites specific aromatic aza-heterocycles, which are disclosed in the specification, including the examples. Claim 6 also adds a limitation that the reaction is carried out at a temperature between room temperature and about 80°C, inclusive (see patent application at page 8, lines 4-14). New claim 7 requires that the aromatic aza-heterocycle be an indole, and claim 8 requires that the reaction be carried out at room temperature. All of these limitations are fully supported in the specification and therefore do not represent new matter.

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IV Restriction Requirement

As indicated above, Applicant has provisionally elected, with traverse, Group VIII. According to the election/restriction requirement, Group VIII is "drawn to a process for making a compound of formula I, wherein R1, R2, R3, R4, and R5 are independently hydrogen, nitro group, or cyano group, alkylcarbonyl, arylcarbonyl or an amide group; and HETN is indole." Applicant submits that claims 3-8, as amended, read on the elected invention.

Applicant respectfully submits that a restriction requirement under PCT rule 13.1 and 13.2 is unwarranted. According to the Restriction Requirement, the claims "lack unity of invention under PCT rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art." To support this contention, the Restriction Requirement states that the "compound claimed contains a phenylindole moiety, which does not define a contribution over the prior art (as can be seen by the compound II of CAS: 123:55807)."

Applicant respectfully submits that, when viewed properly, Rule 13.1 and 13.2 do not support a lack of unity rejection in this case. Applicant submits that rule 13.2 only requires that there be a "technical relationship among those inventions involving one or more of the same or corresponding special technical features," which defines a contribution over the prior art. (Emphasis added.) Rule 13.2 does not require that each of the inventions possess a single feature that defines over the prior art, but may include multiple features, which taken together, define over the prior art. In this regard, Applicant notes that original claims 1-5 recite a process that includes shared "special technical features" that include—in addition to structural elements of the recited reactants and products—reagents, reaction conditions, and so on, which in whole or in part, define over the prior art.

Furthermore, Applicant has amended the claims to recite specific aromatic aza-heterocycles, which should clarify and simplify the search. Applicant therefore submits that the resulting search and subsequent examination would not pose a serious burden on the Patent Office and therefore examination of the entire application is proper.

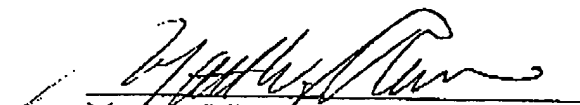
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Applicant believes that no fees are due with respect to the filing of this paper. However, if any fees are due in connection with the filing of this paper, please charge them to deposit account number 23-0455.

Respectfully submitted,

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